



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,845	05/17/2006	Walter Rosenbaum	2004P19118	5727
24131 7590 02/04/2009 LERNER GREENBERG STEMER LLP P O BOX 2480 HOLLYWOOD, FL 33022-2480				
EXAMINER				
CHEN, GEORGE YUNG CHIEH				
ART UNIT		PAPER NUMBER		
3628				
MAIL DATE		DELIVERY MODE		
02/04/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/579,845

**Applicant(s)**

ROSENBAUM, WALTER

**Examiner**

George Chen

**Art Unit**

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**1. DETAILED ACTION**

2. This communication is a final action in response to amendment filed on 11/26/08. Claims 1-12 are pending with claims 1-12 amended.

**3. Response to Amendment**

4. In response to Applicant's amendment, Examiner has withdrawn objections on drawing.
5. In response to Applicant's amendment, Examiner has withdrawn rejection under 35 U.S.C. 101.

**6. Priority**

7. The application claims benefit of PCT/EP04/12915 filed on 11/15/2004. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

**8. Claim Rejections - 35 USC § 103**

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-3, 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman (US 5146403) in view of Nielsen (US 6405243 B1).**

11. As per claim 1, Goodman discloses a method of forwarding post, comprising the steps of:
- ✓ providing a post forwarding apparatus to determine if a current post destination address is expired (see at least Goodman, column 2, line 36-48, the terminals receives and store customized change of address information).

- ✓ if the destination address is expired, automatically determining if an addressee of the post maintains a forwarding service account (see at least Goodman, column 2, line 36-48, a service computer receives the change of address information from all of the terminals), and

Goodman does not explicitly disclose if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address. Nielsen teaches if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address (see at least Nielsen, column 4, line 59 – column 5, line 21, in other words, if enough money is available in one of the recipient's accounts, the address-change server sends the user an email message with the new email address and deducts the transaction fee from the recipient's account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine method of forwarding mail with if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address for the purpose to reduce delays and error (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47).

12. As per claim 2, Goodman discloses the method according to claim 1, but does not explicitly disclose further comprising the step of automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen does not explicitly teach offering a forwarding service account to said addressee if said

addressee does not maintain a forwarding service account. Nielsen, however, teaches offering a forwarding service to customer if said customer does not maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account; and therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine method of forwarding with offering a forwarding service to customer if said customer does not maintain a sufficient funded service account for the purpose to reduce delays and error (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47).

*13.* As per claim 3, Goodman further discloses the method according to claim 2, further comprising the step of not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account. Nielsen does not explicitly disclose not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account. Nielsen, however, teaches not forwarding the post to an addressee destination address if said addressee does not purchase the service (see at least Nielsen, Fig. 3, step 325, wherein if the sender refuses to pay, the process will end immediately).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from not forwarding the post to an addressee

destination address if said addressee does not purchase the service to not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account; and therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine method of forwarding with not forwarding the post to an addressee destination address if said addressee does not purchase the service for the purpose to reduce delays and error (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47).

*14.* As per claim 7, Goodman discloses an apparatus for forwarding post, comprising:

- ✓ means for determining if a current post destination address is expired (see at least Goodman, column 2, line 36-48, the terminals receives and store customized change of address information),
- ✓ means for automatically determining if an addressee of the post maintains a forwarding service account if said destination address is expired (see at least Goodman, column 2, line 36-48, a service computer receives the change of address information from all of the terminals), and

Goodman does not explicitly disclose means for automatically debiting said account in an appropriate amount and forwarding the post to an addressee destination address if said forwarding service account is maintained. Nielsen teaches means for automatically debiting said account in an appropriate amount and forwarding the post to an addressee destination address if said forwarding service account is maintained (see at least Nielsen, column 4, line 59 – column 5, line 21, in other words, if enough money is available in one of the recipient's accounts, the

address-change server sends the user an email message with the new email address and deducts the transaction fee from the recipient's account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine apparatus of forwarding mail with means for automatically debiting said account in an appropriate amount and forwarding the post to an addressee destination address if said forwarding service account is maintained for the purpose to reduce delays and error (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47).

*15.* As per claim 8, Goodman discloses the apparatus according to claim 7, but does not explicitly disclose further comprising means for automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen does not explicitly teach means for automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielson, however, teaches offering a forwarding service to customer if said customer does not maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to means for automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account; and therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine apparatus of forwarding with offering a

forwarding service to customer if said customer does not maintain a sufficient funded service account for the purpose to reduce delays and error (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47).

*16.* As per claim 9, Goodman discloses the apparatus according to claim 8, but does not explicitly disclose further comprising means for not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account. Nielsen does not explicitly teach means for not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account. Nielsen, however, teaches not forwarding the post to an addressee destination address if said addressee does not purchase the service (see at least Nielsen, Fig. 3, step 325, wherein if the sender refuses to pay, the process will end immediately).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from not forwarding the post to an addressee destination address if said addressee does not purchase the service to means for not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account; and therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine method of forwarding with not forwarding the post to an addressee destination address if said addressee does not purchase the service for the purpose to reduce delays and error (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47).

**17. Claims 4-5, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Nielsen, further in view of Kuebert et al. (hereinafter Kuebert, US 20020165729 A1).**

18. As per claim 4, Goodman discloses the method according to claim 3, but does not explicitly disclose wherein said step of not forwarding further comprises the step of destroying the post. Kuebert teaches step of not forwarding further comprises the step of destroying the post (see at least Kuebert, 0055, alternatively, the sender may instruct the shipper to destroy mail item).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine method of forwarding with step of not forwarding further comprises the step of destroying the post for the purpose to reduce delays and error to save time (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47; Kuebert: 0009-0010).

19. As per claim 5, Goodman discloses the method according to claim 4, but does not explicitly disclose wherein said step of not forwarding further comprises a pre-selected time delay prior to destruction of said post. Goodman, however, discloses having a pre-selected time delay prior to next action to ensure user having enough time to make decision (see at least Fig. 10, step 1003, has timer elapsed).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from having a pre-selected time delay prior to next action to ensure user having enough time to make decision to a pre-selected time delay prior to destruction of said post.

20. As per claim 6, Goodman discloses the method according to claim 5, but does not explicitly disclose wherein said steps of determining, further comprises the steps of: scanning an address face of the post for a TAG ID, and consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired and if a redirection fee has been paid. Nielsen teaches consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired and if a redirection fee has been paid (see at least Nielsen, Fig. 3, step 305, search for old email address in database; and see step 315, sufficient funds in account). Kuebert teaches scanning an address face of the post for a TAG ID (see at least Kuebert, Fig. 2, step 205, Capture item image or mailer supplied data).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired and if a redirection fee has been paid with scanning an address face of the post for a TAG ID for the purpose to reduce delays and error to save time (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47; Kuebert: 0009-0010).

21. As per claim 10, Goodman discloses the apparatus according to claim 9, but does not explicitly disclose wherein said means for not forwarding further comprises means for destroying the post. Kuebert teaches means for not forwarding further comprises the means for destroying the post (see at least Kuebert, 0055, alternatively, the sender may instruct the shipper to destroy mail item).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine apparatus of forwarding with means for not forwarding further comprises the means for destroying the post for the purpose to reduce delays and error to save time (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47; Kuebert: 0009-0010).

22. As per claim 11, Goodman discloses the apparatus according to claim 10, but does not explicitly disclose wherein said means for not forwarding further comprises a pre-selected time delay prior to destruction of the post. Goodman, however, discloses having a pre-selected time delay prior to next action to ensure user having enough time to make decision (see at least Fig. 10, step 1003, has timer elapsed).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from having a pre-selected time delay prior to next action to ensure user having enough time to make decision to a pre-selected time delay prior to destruction of said post.

23. As per claim 12, Goodman discloses the apparatus according to claim 11, but does not explicitly disclose wherein said means for determining further comprises: means for scanning an address face of said post for a TAG ID, and means for consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired and if a redirection fee has been paid. Nielsen teaches consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired and if a redirection fee has been paid (see at least Nielsen, Fig. 3, step 305, search for old email address in database; and see step 315, sufficient funds in

account). Kuebert teaches scanning an address face of the post for a TAG ID (see at least Kuebert, Fig. 2, step 205, Capture item image or mailer supplied data).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to combine consulting a database for records related to said TAG ID, said records indicating said TAG ID is expired and if a redirection fee has been paid with scanning an address face of the post for a TAG ID for the purpose to reduce delays and error to save time (Goodman: column 2, line 15-20; Nielson: column 1, line 32-47; Kuebert: 0009-0010).

**24. Please Note:**

25. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

**26. *Response to Argument***

27. Regarding Applicant's argument towards objection on drawings, objection on abstract, rejection under 35 U.S.C. 101

**28. Applicant's arguments have been fully considered and are persuasive.**

29. The objections on drawings, abstract and rejection under 35 U.S.C. 101 have been withdrawn.

30. Regarding Applicant's argument towards rejection under 35 U.S.C. 102 and 103

31. **Applicant's arguments have been fully considered but are moot in view of the new grounds of rejection.**

32. As per Applicant's argument that certain features are not shown in Allen and/or Kuebert and that the combination of Allen and Kuebert is based on hindsight reconstruction, please refer to the office action set forth above under paragraph 8.

### 33. *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Chen whose telephone number is (571)270-5499. The examiner can normally be reached on Mon-Thu 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G.C./

/John W Hayes/  
Supervisory Patent Examiner, Art Unit 3628